

APPLICANT(S): DALTON, James T.  
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## REMARKS

### Status of Claims

Claims 1-9, 12-23, 25-34, 36-67, 69-78 and 80-95 are pending in the application. Claims 21-23, 32-34, 38-51, 65-67, 76-78 and 82-95 have been withdrawn from consideration. Claims 10, 11, 24, 35, 68 and 79 have been cancelled in our previous response. Claims 1-9, 12-20, 24-31, 35-37, 52-64, 68-75 and 79-81 have been rejected.

### Double Patenting Rejections

In the Office Action, the Examiner rejected claims 1-9, 12-20, 24-31, 35-37, 52-64, 68-75 and 79-81 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-85 of US 6,838,484 or over claims 1-10 of US 6,569,896 or over claims 1-5 of US 6,492,554. Applicants disagree.

Applicants are hereby requesting the rejection be held in abeyance until such times as allowable claims are identified.

## CLAIM REJECTIONS

### 35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1-9, 12-20, 24-31, 35-37, 52-64, 68-75 and 79-81 under 35 U.S.C. § 103(a), as allegedly being rendered obvious in view of the combined teaching of Tucker (US 4,636,505) (Tucker '505) and Miller et al (WO 98/55153) (Miller '153). Applicants disagree.

The Examiner alleges, in the Final Office Action filed March 28, 2008 that "Tucker is expressly teaching the equivalence of O-bridged compound[s] and S-bridged compounds, see column 9", and therefore alleging an equivalence of metabolites between the compounds of Tucker's '505 and the rejected claims. Applicants disagree.

Applicants submit that column 9, Example 2 of Tucker '505, describes the synthetic process "using an appropriate aniline and an appropriate 2-hydroxy-substituted alkanoic

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acid", for the compounds listed in the table presented therein. The only property expressly disclosed for these compounds is the physical property of melting point and in this there is a wide range, including compounds present as a gum. The USPTO Manual of Patent Examining Procedure section 2144.06 II states:

"In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (The mere fact that components are claimed as members of a Markush group cannot be relied upon to establish the equivalency of these components.)"

Applicants submit that no where in Example 2 does Tucker '505 describe, recognize, suggest or lay the foundation for the equivalence of the group of compounds listed. Applicants submit Tucker '505 does not teach equivalent compounds with those of the subject Application and hence, does not teach equivalent metabolites.

The Examiner alleges, in the Final Office Action filed March 28, 2008, that the compounds of Miller '153 have an "inherent property" such that when administered *in-vivo* "these derivatives are going to be hydroxylated, hydrolyzed or deacylated" resulting in production of the metabolites of the subject Application. Applicants disagree.

Applicants assert that Miller '153 explicitly negates any knowledge of *in-vivo* metabolites on page 42, lines 24-25, stating: "Nothing is known about the *in vivo* metabolism and pharmacokinetics of compounds of the present invention." Further, The Manual of Patent Examining Procedures section 2112-IV, states, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' ". Applicants submit that as Miller '153 claims no knowledge of the *in vivo* metabolism of the compounds of the invention, one skilled in the art would not recognize as obvious the metabolites claimed in the subject Application based on Miller '153.

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Applicants contend the neither Tucker '505 nor Miller '153 provide guidance or disclosure regarding identity of metabolites of compounds disclosed in their respective patent and patent application, which would lead in combination to the metabolites of the subject Application. In regard to teaching the metabolites of the compounds of Tucker '505, Tucker '505 discloses lack of knowledge, at the time, as to the exact metabolite(s) of the many acylanilide anti-androgenic compounds. Specifically, column 1 lines 20-22 of Tucker '505, states that: "It is believed that [the antiandrogen] Flutamide is oxidized *in vivo* to the corresponding compounds wherein R is hydroxy." Tucker '505 provides no further evidence or knowledge of metabolites of compounds disclosed therein. Applicants submit that Example 5 of the subject Application demonstrates that the metabolism of O-bridged SARM compounds differs substantially from that of S-bridged compounds presented in Tucker.

Applicants recall Miller's '153 statement on page 42, lines 24-25, that: "Nothing is known about the *in vivo* metabolism and pharmacokinetics of compounds of the present invention." Applicants submit that, Miller '153, page 42 lines 25-27, then "hypothesizes" that the compounds of the present invention (Miller '153): "are likely to undergo *in vivo* disposition like bicalutamide and flutamide." Miller further states on page 42, lines 24-25,: "Nothing is known about the *in vivo* metabolism and pharmacokinetics of compounds of the present invention. Applicants assert that Miller's '153 hypothesis teaches the oxidation of a thioether linkage to a sulfonyl linkage of bicalutamide away from the metabolites represented by O-bridged SARM formulas I, II, III, IV, VII, VIII, IX and X of the subject Application, which posses an ether linkage and are therefore not oxidized at the corresponding site in the molecules. Further, the differences between metabolic products of bicalutamide and the metabolites of subject Claims, is specifically exemplified in Example 5 of the subject Application.

Moreover, Miller '153 teaches, on page 42 lines 27-31, that metabolites of the S-bridged SARM bicalutamide are not even present in a time scale relevant to activities being measured *in vivo* and therefore contribute little "during *in vivo* studies". Applicants assert that, therefore, the teachings of Miller '153 contest the relevancy of the Examiner's assertion that: The teachings of Miller '153 make obvious the metabolites claimed in the subject Application due to the "simple biological phenomenon, which, is conversion of any substance

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in vivo which have [sic] to be converted to various derivatives, absent evidence to the contrary".

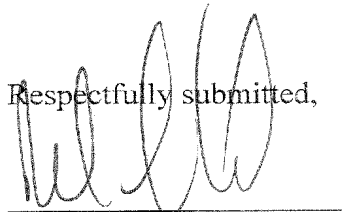
Applicants maintain that neither Tucker '505 nor Miller '153, alone or in combination, disclose, suggest or lead one skilled in the art to the O-bridge SARM metabolites of the subject Claims. Accordingly, Applicants request withdrawal of the rejection.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



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